

Applic. No. 10/766,593
Amdt. dated January 31, 2006
Reply to Office action of November 4, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1, 3-5, and 7-21 remain in the application. Claims 2 and 6 were previously cancelled. Claims 5 and 7-21 have been withdrawn from consideration.

In item 2 on page 2 of the above-identified Office action, claims 1, 3, and 4 have been rejected as being obvious over Sinn et al. (U.S. Patent No. 6,106,453) in view of Schulz et al. (U.S. Patent Publication No. 2003/0045412 A1) (hereinafter "Schulz") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

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an aluminum plate having a thickness, a hard-anodized top layer, and a scoring groove formed therein, the scoring groove having a residual thickness of at least 0.1 mm.

In the last paragraph on page 2 of the Office action the Examiner stated that "it is to be noted that providing a groove having a thickness of 0.1 mm ... is routine skill in the art". Applicants respectfully disagree with the Examiner.

The Sinn reference discloses a steel scoring plate (7) that is disposed on a flat counter-pressure plate (4). The steel scoring plate (7) has score grooves (8a, 8b). Sinn is silent as the residual thickness of the score grooves (8a, 8b).

It is noted that claim 1 calls for a "the scoring groove having a residual thickness of at least 0.1 mm." As seen from page 9, lines 9-11 of the specification of the instant application, it is disclosed that at the base of the scoring groove structure there remains a residual thickness of the carrier layer which, for example, is at least 0.1 millimeter, so that the scoring groove structure has a base and is open only on one side. Contrary to the Examiner's interpretation, the "residual thickness" is not the depth of the scoring groove, instead it is the material that remains at the bottom of the score groove. In order to further clarify the

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definition of residual thickness for the Examiner, enclosed herewith is a definition of "score residual" from a website which manufactures equipment for measuring "score residual". Furthermore, there are numerous U.S. patents, which use the terminology, such as U.S. Patent No. 5,860,553. Accordingly, the term "residual thickness" as used in claim 1, is not synonymous with the depth of the score.

Furthermore, the Examiner is respectfully directed to page 9 line 6 to page 10, line 6 of the specification of the instant application, where it is disclosed that the residual thickness of the score groove is at least 0.1 millimeter. It is disclosed that the base is advantageous with regard to a use of the punching and scoring backing plate as a cylinder cover. It is disclosed that the punching and scoring backing plate has to be clamped onto an impression cylinder for the purpose of rotational punching and scoring. When the punching and scoring backing plate is clamped on, it is subjected to bending and clamping forces which entail the risk that the punching and scoring backing plate will curve or curl up in the vicinity of scoring grooves that extend axially parallel with the impression cylinder if these scoring grooves were to be produced as through-holes. The instant application discloses that since these scoring grooves are instead manufactured as blind holes according to the development or

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mode described herein, assurance is offered that the punching and scoring backing plate will not warp when it is clamped on. The Sinn reference pertains to a flat, steel scoring plate that is clamped onto a flat backing plate and not to an aluminum plate that is clamped onto a score on an impression cylinder. Sinn does not disclose the residual thickness of the scoring groove to be at least 0.1 mm. Therefore, it is respectfully believed that the Examiner's comments that providing a groove having a thickness of 0.1 mm is routine skill in the art, is not at all accurate.

Moreover, it is respectfully noted that the Examiner's comments in item 2 of the Office action that Sinn does not disclose the material of the scoring plate, is wrong. The Sinn reference explicitly discloses that the scoring plate is made of steel. Sinn explicitly discloses in column 3, lines 58-59, "a steel punching/scoring plate 7." In the background of the invention, Sinn discloses strip steel punching and scoring tools. Accordingly, not only is Sinn not silent about the material of the scoring plate (7), he explicitly discloses that it is made of steel. Therefore, it is respectfully noted that the Examiner's comments that Sinn is silent with respect to the material of the scoring plate are incorrect.

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It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest an aluminum plate having a thickness, a hard-anodized top layer, and a scoring groove formed therein, the scoring groove having a residual thickness of at least 0.1 mm, as recited in claim 1 of the instant application.

As seen from the above given remarks, Sinn is silent as to the score residual thickness, while he does explicitly disclose that the scoring plate be made of steel. Sinn does not disclose an aluminum scoring plate that the scoring groove has a residual thickness of at least 0.1 mm.

Because Sinn explicitly discloses a steel scoring plate, the Schultz reference does not make up for the deficiencies of Sinn.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

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Furthermore, a person of ordinary skill in the art of scoring tools knows that scoring tools need to be durable in order to have a long tool life. It is exactly for this reason that Sinn explicitly discloses that the scoring plate (7) is made of steel.

Therefore, a person of ordinary skill in the art would not modify the scoring plate of Sinn to be made of aluminum, as suggested by the Examiner. This is because it would reduce the tooling life of the scoring plate, thereby destroying an intended function of the scoring plate. Since the modification of the scoring plate of Sinn as suggested by the Examiner would destroy its intended function, there is no motivation to combine Sinn and Schulz.

Since claim 1 is believed to be allowable, dependent claims 3 and 4 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

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In view of the foregoing, reconsideration and allowance of
claims 1, 3-5, and 7-21 are solicited.

In the event the Examiner should still find any of the claims
to be unpatentable, counsel respectfully requests a telephone
call so that, if possible, patentable language can be worked
out.

If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,



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